



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,345	03/01/2002	Chung Owyang	UM-06962	3068

7590 06/09/2004
Tanya A. Arenson
MEDLEN & CARROLL, LLP
Suite 350
101 Howard Street
San Francisco, CA 94105

EXAMINER

SULLIVAN, DANIEL M

ART UNIT PAPER NUMBER

1636

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,345

Applicant(s)

OWYANG, CHUNG

Examiner

Daniel M Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5 and 6 is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/1/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 1636

DETAILED ACTION

This Office Action is a reply to the Paper filed 1 March 2004 in response to the Non-Final Office Action mailed 25 November 2003. Claims 1-6 and 10-12 were considered in the 25 November Office Action. Claims 2-4 and 10 were canceled and claims 1 and 6 were amended in the 1 March Paper. Claims 1, 5, 6, 11 and 12 are pending and under consideration.

Information Disclosure Statement

The Information Disclosure Statement filed 1 March 2004 has been considered in part. Those references lined through on the form PTO-1449 have not been considered for the reason stated on the form, or were previously made of record on the form PTO-892 mailed with the 25 November Office Action.

Response to Amendment

Rejection of claims 2-4 and 10 is rendered moot by cancellation of the claims.

Claim Rejections - 35 USC § 112

Rejection of claims 1, 5 and 6 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendments to claim 1.

Rejection of claims 1, 5 and 6 under 35 U.S.C. 112, first paragraph, as lacking enablement for the full scope of the claimed subject matter is withdrawn in view of the amendments to claims 1 and 6.

Art Unit: 1636

Claims 11 and 12 stand rejected under 35 U.S.C. 112, first paragraph, as lacking enablement for the full scope of the claimed subject matter for reasons of record and herein below in the response to arguments.

Claim Rejections - 35 USC § 102

Rejection of claims 1, 5 and 6 under 35 U.S.C. 102(b) as being anticipated by any one of Pan *et al.* (1998) *FEBS Lett.* 435:65-68, Chen *et al.* (1994) *FEBS Lett.* 147 :279-283, Pan *et al.* (1995) *Mol. Pharmacol.* 47:1180-1188, Bunzow *et al.* (1994) *FEBS Lett.* 347 :284-288, Wick *et al.* (1994) *Brain Res. Mol. Brain Res.* 27:37-44, Grandy *et al.* (U.S. Patent No. 5,821,067), or Eppler *et al.* (U.S. Patent No. 5,866,324) is withdrawn in view of the amendments to claim 1.

Rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by NCBI Entrez Nucleotide Database Accession Number U05239.1 (GI:45183) is withdrawn in view of the amendments thereto.

Rejection of claims 1 and 6 rejected under 35 U.S.C. 102(e) as being anticipated by Yu (U.S. Patent No. 6,103,492) is withdrawn in view of the amendments to claim 1.

Response to Arguments

Claim Rejections - 35 USC § 112

Claims 1, 6, 11 and 12 were rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid, and an isolated cell comprising the vector of claim 5, to the extent that the nucleic acid and vector comprises a sequence indicated to be adequately described and enabled, does not reasonably provide enablement for any composition comprising the isolated nucleic acid. The Office Action stated that, because the term “composition” is not defined in the specification, the claimed composition is understood, according to its broadest reasonable interpretation, to encompass any composition of matter wherein an isolated nucleic acid according to the claims is present. Further, as the specification specifically contemplates transgenic animals comprising the nucleic acid (see especially the paragraph bridging pages 25-26), the claimed composition is understood to encompass a transgenic animal, which is not enabled by the disclosure.

In response to the *prima facie* case, Applicant has amended claims 1 and 6 such that they are limited to an isolated nucleic acid or a cell *in vitro*. Applicant argues that the claims are now limited to embodiments that are acknowledged to be enabled by the Examiner. While this is true with respect to claims 1 and 6, neither the amendments nor the remarks filed in the 1 March Paper address the rejection as it is set forth against claims 11 and 12. Therefore, claims 11 and 12 stand rejected under 35 U.S.C. §112, first paragraph, as lacking enablement for the full scope of the claimed subject matter.

Allowable Subject Matter

Claims 1, 5 and 6 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1636

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMS


DAVID GUZO
PRIMARY EXAMINER